



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/511,610	04/18/2005	Renato Cantini	261204US2XPCT	7462

22850 7590 07/17/2006

OBLON, SPIVAK, MCCLELLAND, MAIER & NEUSTADT, P.C.
1940 DUKE STREET
ALEXANDRIA, VA 22314

EXAMINER

SAFAIPOUR, BOBBAK

ART UNIT	PAPER NUMBER
----------	--------------

2631

DATE MAILED: 07/17/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/511,610

Applicant(s)

CANTINI ET AL.

Examiner

Bobbak Safaipoor

Art Unit

2631

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 31 January 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-15 is/are pending in the application.
- 4a) Of the above claim(s) 5,6,11 and 12 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-4, 7-10, 13-15 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 4 November 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>11/4/2004</u> | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Priority

1. Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

Information Disclosure Statement

2. The information disclosure statement submitted on 11/4/2004 has been considered by the Examiner and made of record in the application file.

Claim Objections

3. **Claims 5, 6, 11, and 12** are objected to under 37 CFR 1.75(c) as being in improper form because a multiple dependent claim cannot depend from any other multiple dependent claim. See MPEP § 608.01(n). Accordingly, the claims have not been further treated on the merits.
4. On **lines 3 of claim 1**, insert --s-- after “chipcard” to make it read “chipcards”.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

6. **Claims 1-4, 7-10, and 13-15** are rejected under 35 U.S.C. 102(e) as being anticipated by **Wong (US Patent # 7,039,403 B2)**.

Consider **claim 1**, Wong clearly shows and discloses the claimed invention wherein a method for management of resources of portable resource modules (1), which modules are each connected to a communication terminal (2) and are designed in particular as chipcards, the resources comprising electronic memory units (11), the method comprising:

transmitting a first resource management instruction comprising a module identification to a resource management centre (4) (figure 2; col. 3, lines 58-62; The provisioning system 104 communicates the IMSI (International Mobile Subscriber Identity) 103 and the registration MSISDN (mobile station integrated service digital network) 105 to the HLR 102),

transmitting a second resource management instruction from the resource management centre (4) via a communication network (3) to the resource module (1) identified through the module identification (figure 2; col. 3, lines 21-24, 62-67; The HLR 102 performs a registration of the IMSI 103 and returns an acknowledgment (ACK), and in response to the ACK, the provisioning system 104 returns a registration confirmation to the sales computer 106, which is a data processing device that manipulates information from device 108 which comprises a subscriber identity module (SIM) 101),

making ready or releasing resources, in accordance with the received second resource management instruction, through a resource control mechanism (111) in the identified resource module (1) (figure 2; col. 3, lines 48-52; The provisioning system 104 comprises data processing capabilities, e.g. a processor and memory, to perform operations according to the received information),

transmitting a resource management confirmation from the identified resource module (1) via the communication network (3) to the resource management centre (4) (figure 2; col. 3, lines 62-63; The HLR 102 performs a registration of the IMSI 103 and returns an acknowledgement (ACK)), and

storing information in the resource management centre (4) about the resources made ready or released, the information being stored assigned to the module identification (figures 2-3; col. 5, lines 15-17; HLR 102 comprises machine-readable media for storage of information such as computer readable instructions, data structures, program modules or other data).

Consider **claim 2**, and **as applied to claim 1 above**, Wong clearly shows and discloses the claimed invention wherein the module identification and an application request are transmitted by the user of the communication terminal (2) to an application management unit (5) (figure 2; col. 3, lines 41-47, 60-62; In order for the customer to access the wireless network, the sales computer 106 communicates the IMSI 103 and a registration request to a provisional system 104 and communicates the IMSI 103 and registration MSISDN 105 to the HLR 102), wherein the first resource management instruction is transmitted by the application management unit (5) to the resource management centre (4) on the basis of the received application request (figure 2; col. 3, lines 62-67; col. 4, lines 1-4; The HLR 102 performs a registration of the IMSI 103 and returns an acknowledgement ACK. The customer can now access the wireless network by way of the MSC 114, which communicates with the HLR 102 to verify the customers registration), the first resource management instruction comprising a resource user identification (figure 2; col. 3, lines 41-45; IMSI 103 with a registration MSISDN 105), and wherein the resource user identification is stored, assigned to the module identification, in the resource

management centre (4) (figures 2-3; col. 5, lines 15-17; HLR 102 comprises machine-readable media for storage of information such as computer readable instructions, data structures, program modules or other data).

Consider **claim 3**, and **as applied to claim 2 above**, Wong clearly shows and discloses the claimed invention wherein a resource preparation confirmation is transmitted from the resource management centre (4) to the application management unit (5) (figure 2; col. 3, lines 62-63; The HLR 102 performs a registration of the IMSI 103 and returns an acknowledgement (ACK)), wherein an application installation request is transmitted from the application management unit (5) via the communication network (3) to the particular resource module (1), wherein an application is installed in the particular resource module (1) through the resource control mechanism (111) in accordance with the application installation request using the prepared resources, and wherein information about the installed application is stored in the application management unit (5), the information being stored assigned to the module identification (col. 5, lines 3-17; The HLR 102 comprises machine-readable media comprising machine-executable instructions, including, but not limited to volatile and/or non-volatile media, removable and/or non-removable media, including RAM, ROM, EEPROM, flash memory or other memory technology, CD-ROM, digital versatile disks (DVD) or other optical storage, magnetic cassettes, magnetic tape, magnetic disk storage or other magnetic storage devices, or any other information storage medium. The machine readable media may be implemented in any method or technology for storage of information such as computer readable instructions, data structures, program modules or other data).

Consider **claim 4**, and **as applied to one of the claims 1 or 2**, Wong clearly shows and discloses the claimed invention wherein the resource management centre (4) an application installation request is inserted into the second resource management instruction (figure 2; col. 3, lines 41-47, 60-62; In order for the customer to access the wireless network, the sales computer 106 communicates the IMSI 103 and a registration request to a provisional system 104 and communicates the IMSI 103 and registration MSISDN 105 to the HLR 102), wherein an application is installed in the particular resource module (1) through the resource control mechanism (111) in accordance with the application installation request, and wherein information about the installed application is stored in the resource management centre (4), the information being stored assigned to the module identification (col. 5, lines 3-17; The HLR 102 comprises machine-readable media comprising machine-executable instructions, including, but not limited to volatile and/or non-volatile media, removable and/or non-removable media, including RAM, ROM, EEPROM, flash memory or other memory technology, CD-ROM, digital versatile disks (DVD) or other optical storage, magnetic cassettes, magnetic tape, magnetic disk storage or other magnetic storage devices, or any other information storage medium. The machine readable media may be implemented in any method or technology for storage of information such as computer readable instructions, data structures, program modules or other data).

Consider **claim 7**, Wong clearly shows and discloses a multiplicity of portable resource modules (1, 1'), each connected to a communication terminal (2, 2', 2'') and each comprising a resource control mechanism (111) for making ready and releasing resources in the respective

resource module (1, 1'), the resources comprising electronic memory units (11), and which portable resource modules are designed in particular as chipcards, wherein

the system comprises a resource management centre (4) with a receiving module (43) for receiving a first resource management instruction, comprising a module identification, transmitted to the resource management centre (4) (figure 2; col. 3, lines 58-62; The provisioning system 104 communicates the IMSI (International Mobile Subscriber Identity) 103 and the registration MSISDN (mobile station integrated service digital network) 105 to the HLR 102),

the resource management centre (4) comprises a management instruction module (44) for transmitting to the resource module (1) identified by the module identification a second resource management instruction via a communication network (3) connected to the resource management centre (4) (figure 2; col. 3, lines 21-24, 62-67; The HLR 102 performs a registration of the IMSI 103 and returns an acknowledgment (ACK), and in response to the ACK, the provisioning system 104 returns a registration confirmation to the sales computer 106, which is a data processing device that manipulates information from device 108 which comprises a subscriber identity module (SIM) 101),

the resource modules (1) each comprise a confirmation module (112) for transmission of a resource management confirmation via the communication network (3) to the resource management centre (4) concerning resources which have been made ready or released through the resource control mechanism (111) in accordance with a received second resource management instruction (figure 2; col. 3, lines 48-52; The provisioning system 104 comprises data processing capabilities, e.g. a processor and memory, to perform operations according to the received information), and

the resource management centre (4) comprises a management module (45) and a data store (41) for storing information about the resources made ready or released, the information being stored assigned to the module identification (figures 2-3; col. 5, lines 15-17; HLR 102 comprises machine-readable media for storage of information such as computer readable instructions, data structures, program modules or other data).

Consider **claim 8**, and **as applied to claim 7 above**, Wong clearly shows and discloses the claimed invention wherein the system comprises an application management unit (5) for receiving the module identification and an application request from the user of the communication terminal (2) (figure 2; col. 3, lines 41-47, 60-62; In order for the customer to access the wireless network, the sales computer 106 communicates the IMSI 103 and a registration request to a provisional system 104 and communicates the IMSI 103 and registration MSISDN 105 to the HLR 102) and for transmitting the first resource management instruction to the resource management centre (4) on the basis of the received application request (figure 2; col. 3, lines 62-67; col. 4, lines 1-4; The HLR 102 performs a registration of the IMSI 103 and returns an acknowledgement ACK. The customer can now access the wireless network by way of the MSC 114, which communicates with the HLR 102 to verify the customers registration), the first resource management instruction comprising a resource user identification (figure 2; col. 3, lines 41-45; IMSI 103 with a registration MSISDN 105), and wherein the management module (45) comprises means for storing in the data store (41) the resource user identification in a way assigned to the module identification (figures 2-3; col. 5, lines 15-17; HLR 102 comprises machine-readable media for storage of information such as computer readable instructions, data structures, program modules or other data).

Consider **claim 9**, and **as applied to claim 8 above**, Wong clearly shows and discloses the claimed invention wherein the resource management module (4) comprises a confirmation module (46) for transmission of a resource preparation confirmation to the application management unit (5) (figure 2; col. 3, lines 62-63; The HLR 102 performs a registration of the IMSI 103 and returns an acknowledgement (ACK)), wherein the application management unit (5) comprises an application instructions module (54) for transmitting an application installation request via the communication network (3) to the particular resource module (1), wherein the resource control mechanism (111) comprises means for installing an application in the respective resource module (1) in accordance with the application installation request and using the prepared resources, and wherein the application management unit (5) comprises an application management module (55) for storing information about the installed application, the information being stored assigned to the module identification (col. 5, lines 3-17; The HLR 102 comprises machine-readable media comprising machine-executable instructions, including, but not limited to volatile and/or non-volatile media, removable and/or non-removable media, including RAM, ROM, EEPROM, flash memory or other memory technology, CD-ROM, digital versatile disks (DVD) or other optical storage, magnetic cassettes, magnetic tape, magnetic disk storage or other magnetic storage devices, or any other information storage medium. The machine readable media may be implemented in any method or technology for storage of information such as computer readable instructions, data structures, program modules or other data).

Consider **claim 10**, and **as applied to one of the claims 7 or 8**, Wong clearly shows and discloses the claimed invention wherein the management instruction module (44) comprises means for inserting an application installation request into the second resource management

instruction (figure 2; col. 3, lines 41-47, 60-62; In order for the customer to access the wireless network, the sales computer 106 communicates the IMSI 103 and a registration request to a provisional system 104 and communicates the IMSI 103 and registration MSISDN 105 to the HLR 102), wherein the resource control mechanism (111) comprises means of installing an application in the respective resource module (1) in accordance with the application installation request, and wherein the management module (45) comprises means for storing information about the installed application, the information being stored, assigned to the module identification, in the data store (41) (col. 5, lines 3-17; The HLR 102 comprises machine-readable media comprising machine-executable instructions, including, but not limited to volatile and/or non-volatile media, removable and/or non-removable media, including RAM, ROM, EEPROM, flash memory or other memory technology, CD-ROM, digital versatile disks (DVD) or other optical storage, magnetic cassettes, magnetic tape, magnetic disk storage or other magnetic storage devices, or any other information storage medium. The machine readable media may be implemented in any method or technology for storage of information such as computer readable instructions, data structures, program modules or other data).

Consider **claim 13**, Wong clearly shows and discloses a resource management centre (4) for management of resources of portable resource modules (1, 1'), each connected to a communication terminal (2, 2', 2''), and each comprising a resource control mechanism (111) for making ready and releasing resources in the respective resource module (1), the resources comprising electronic memory units (11), and which portable resource modules are designed in particular as chipcards,

wherein the resource management centre (4) comprises a receiving module (43) for receiving a first resource management instruction, comprising a module identification, transmitted to the resource management centre (4) (figure 2; col. 3, lines 58-62; The provisioning system 104 communicates the IMSI (International Mobile Subscriber Identity) 103 and the registration MSISDN (mobile station integrated service digital network) 105 to the HLR 102),

wherein the resource management centre (4) comprises a management instruction module (44) for transmitting to the resource module (1) identified through the module identification a second resource management instruction via a communication network (3) connectible to the resource management centre (4) (figure 2; col. 3, lines 21-24, 62-67; The HLR 102 performs a registration of the IMSI 103 and returns an acknowledgment (ACK), and in response to the ACK, the provisioning system 104 returns a registration confirmation to the sales computer 106, which is a data processing device that manipulates information from device 108 which comprises a subscriber identity module (SIM) 101),

wherein the resource management centre (4) comprises means for receiving a resource management confirmation via the communication network (3) from the identified resource module (1) concerning resources which have been made ready or released through the resource control mechanism (111) in accordance with the received second resource management instruction (figure 2; col. 3, lines 48-52; The provisioning system 104 comprises data processing capabilities, e.g. a processor and memory, to perform operations according to the received information), and

wherein the resource management centre (4) comprises a management module (45) and a data store (41) for storing information about the resources made ready or released, the

information being stored in a way assigned to the module identification (figures 2-3; col. 5, lines 15-17; HLR 102 comprises machine-readable media for storage of information such as computer readable instructions, data structures, program modules or other data).

Consider **claim 14**, and as applied to claim 13 above, Wong clearly shows and discloses the claimed invention wherein the management instruction module (44) comprises means for inserting an application installation request into the second resource management instruction (figure 2; col. 3, lines 41-47, 60-62; In order for the customer to access the wireless network, the sales computer 106 communicates the IMSI 103 and a registration request to a provisional system 104 and communicates the IMSI 103 and registration MSISDN 105 to the HLR 102), and wherein the management module (45) comprises means for storing information about an application installed in the particular resource module (1) in accordance with the application installation request, the information being stored, assigned to the module identification, in the data store (41) (col. 5, lines 3-17; The HLR 102 comprises machine-readable media comprising machine-executable instructions, including, but not limited to volatile and/or non-volatile media, removable and/or non-removable media, including RAM, ROM, EEPROM, flash memory or other memory technology, CD-ROM, digital versatile disks (DVD) or other optical storage, magnetic cassettes, magnetic tape, magnetic disk storage or other magnetic storage devices, or any other information storage medium. The machine readable media may be implemented in any method or technology for storage of information such as computer readable instructions, data structures, program modules or other data).

Consider **claim 15**, and as applied to claim 13 above, Wong clearly shows and discloses the claimed invention wherein the resource management centre (4) comprises a confirmation

Art Unit: 2631

module (46) for transmitting a resource preparation confirmation to an application management unit (5) from which the first resource management instruction was received by the receiving module (43) (figure 2; col. 3, lines 62-63; The HLR 102 performs a registration of the IMSI 103 and returns an acknowledgement (ACK)), wherein the management module (45) comprises means for storing a resource user identification contained in the first resource management instruction, the resource user identification being stored, assigned to the module identification, in the data store (41) (col. 5, lines 3-17; The HLR 102 comprises machine-readable media comprising machine-executable instructions, including, but not limited to volatile and/or non-volatile media, removable and/or non-removable media, including RAM, ROM, EEPROM, flash memory or other memory technology, CD-ROM, digital versatile disks (DVD) or other optical storage, magnetic cassettes, magnetic tape, magnetic disk storage or other magnetic storage devices, or any other information storage medium. The machine readable media may be implemented in any method or technology for storage of information such as computer readable instructions, data structures, program modules or other data).

Conclusion

7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Hoshino: United States Patent #6,003,113.

8. Any response to this Office Action should be **faxed to (571) 273-8300 or mailed to:**

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Hand-delivered responses should be brought to

Customer Service Window
Randolph Building
401 Dulany Street
Alexandria, VA 22314

Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Bobbak Safaipoor whose telephone number is (571) 270-1092. The Examiner can normally be reached on Monday-Friday from 9:00am to 5:00pm.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Rafael Perez-Gutierrez can be reached on (571) 272-7915. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR

Art Unit: 2631

system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free) or 703-305-3028.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist/customer service whose telephone number is (571) 272-2600.

Bobbak Safaipour
B.S./bs

July 6, 2006

EDAN ORGAD
PATENT EXAMINER/TELECOMM.

Edan Orgad 7/10/06